

REMARKS

This Amendment is being filed in response to the Final Office Action mailed August 19, 2008, which has been reviewed and carefully considered. Reconsideration and allowance of the present application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-2 and 4-14 remain in this application, where claim 1 is independent.

In the Final Office Action, claims 1-2 and 5-14 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent Application Publication No. 2002/0024915 (Endoh). Further, claim 4 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Endoh in view of U.S. Patent No. 5,627,817 (Rosen). It is respectfully submitted that claims 1-2 and 4-14 are patentable over Endoh and Rosen for at least the following reasons.

Endoh is directed to an optical recording medium that includes a wobbling groove 5 and a straight groove 6 formed around a shallow groove 7. As clearly shown in FIG 3, and specifically recited in paragraph [0063], "there is formed a shallow groove 7 of a depth

shallower than the depth of the wobbling groove 5." (Emphasis added)

In stark contrast, the present invention as recited in independent claim 1, amongst other patentable elements recites (illustrative emphasis provided):

wherein the height of said barrier is equal to the height of the substrate between two neighboring main.

These features are nowhere disclosed or suggested in Endoh. It is alleged on page 2 of the Final Office Action that "in Fig 3 of Endoh the height of the barrier is smaller than or could be equal to the height of the substrate between two neighboring main groove. (Emphasis added)

It is respectfully submitted that the mere fact that the prior art device could be modified so as to produce the claimed device is insufficient to prove a prima facie case, and is not a basis for an anticipation or an obviousness rejection unless the prior art suggested the desirability of the modification, where Endoh does not provide any such suggestion. See MPEP 2143.01; In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); In re Gordon,

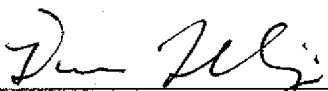
733 F.2d 900, 902 (Fed. Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989). Rosen is cited in rejecting dependent claims to allegedly show other features and does not remedy the deficiencies in Endoh.

Accordingly, it is respectfully submitted that independent claim 1 should be allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2 and 4-14 should also be allowed at least based on their dependence from amended independent claim 1.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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